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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/676,579 | 09/30/2003 | Michael D. Lowery | 17488 | 7885 |
| 7590 | 12/01/2004 | | | |
| Peter J. Gluck 1700 E. St. Andrew Place Santa Ana, CA 92705 | | | EXAMINER ZIMMER, MARC S | |
| | | | ART UNIT 1712 | PAPER NUMBER |

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/676,579 | LOWERY, MICHAEL D. |
| | Examiner | Art Unit |
| | Marc S. Zimmer | 1712 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-3,5,7,8,10 and 21-27 is/are allowed.
- 6) Claim(s) 9 and 11-19 is/are rejected.
- 7) Claim(s) 4,6,14,16 and 20 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Claim Objections

Claims 4 and 14 are objected due to the following: the first paragraph of page 18 of the Specification would seem to suggest that it is an objective of the invention to formulate a polyorganosiloxane composition containing a treated silica filler wherein the refractive index of the filled composition is at least 1.46. There is no express mention that the treated silica reinforcer by itself must meet this requirement (though it is appreciated that, for optical applications, it is desirable that the polymer matrix and filler have matching refractive indices). If Applicant had, in fact, intended to claim a silica reinforcer that adheres to this limitation than disclosure of this aspect should be inserted into the Specification in the appropriate place.

The word "one" should be inserted into claims 1 and 11 right before the first mention of an aryl group.

For added clarity, the phrase "multiple bond" in each of claims 10, 20, and 21 should be replaced with "carbon-carbon double bond".

Claims 6 and 16 are objected to under 37 CFR 1.75 as being a substantial duplicates of claims 3 and 13 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claim 3 for the moieties recited in claim 9.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kennan et al., U.S. Patent # 5,008,305. Kennan discloses silicone elastomer compositions (column 4, lines 37-38 and column 7, lines 48-63) that comprise (i) a base siloxane polymer substituted largely with methyl groups but also containing small amounts of vinyl and phenyl groups to tailor the properties of said polymer, (ii) a crosslinking agent, (iii) a platinum hydrosilylation catalyst, and (iv) a treated silica filler that represents the novel aspect of their invention. The silica filler is one that has been treated with a combination of silane treating agents, one of which bears vinyl moieties and the other phenyl groups (column 3, lines 53-68 through column 4, lines 1-5). Preferred treating agents are outlined in column 5, lines 63-67.

Claim Rejections - 35 USC § 102

Claims 11-12, 14, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki, U.S. patent # 4,560,711. Suzuki discloses a transparent

polysiloxane composition comprising the materials set forth in column 1, lines 49-68 through column 2, lines 1-3. Examples of the favored aryl-substituted silane or siloxane oligomer employed as treating agents for the silica filler are presented in column 3. Relevant to claim 14, each of the embodiments disclosed by way of Example has a refractive index of 1.469 or greater. This parameter is that for the entire composition but the importance of having the refractive indices of the polymer and adjuvant match is emphasized in the Background section. Hence, it is the position of the Examiner that the treated silica mentioned in the Examples will inherently possess the refractive index mandated by claim 14.

Allowable Subject Matter

Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-10 and 21-27 are allowable over the prior art. Ohtake et al., U.S. patent # 4,269,993, McGill et al., U.S. patent # 6,630,560 (example 1), and the abstract for GB 611700 all disclose siloxane polymers wherein one or more of the backbone silicon atoms are bonded to two aralkyl substituents but, in all cases, the polymers are devoid of terminal ethylenically-unsaturated hydrocarbon groups. The prior art did not contemplate an IOL featuring silica filler that has been treated with an aryl group-containing organosilicon compound.

EP 236 674 discloses much the same invention as does Kennan. Insofar as it reads only on the claims already rejected against Kennan, it will not be applied as a reference herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 29, 2004

Marc S. Zimmer

Marc Zimmer
AV 1712